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Fumakilla Ltd v The Registrar of Trademarks

B HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NO WA-24IP-1–01 OF 2023
AZLAN SULAIMAN JC
15 JUNE 2023

C *Trademarks — Application for registration — Rejection of application — Whether applicant had shown mark contained or consisted of at least one of the particulars under s 10(1)(c), (d) or (e) of Trade Marks Act 1976 to qualify it for registration — Whether Registrar of Trademarks erred in refusing registration on ground the aforesaid requirements had not been satisfied — Whether trademark registration was territorial in nature — Whether Registrar in Malaysia was not bound to register mark simply because it had been registered in other countries*

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The instant appeal under s 25(5) of the Trade Marks Act 1976 ('the TMA') was against the defendant's rejection of the appellant's application to register its trademark for goods in Class 3 in respect of 'fragrance preparations'. The appellant's mark consisted of the word 'KAORI' immediately below which were some characters in the Japanese language. The defendant rejected the appellant's application on the ground that the mark was not registrable as it failed to contain or consist of at least one of the particulars under s 10(1)(c), (d) or (e) of the TMA (paras (a) and (b) were not applicable in the instant case). In other words, for the mark to be registrable, it had to be 'an invented word or words' or 'a word having no direct relevance to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname' or 'any other distinctive mark'. The appellant argued that the defendant erred not only in her application of s 10(1) of the TMA to the facts of the case, but also failed to consider sufficiently or at all that the appellant's mark had been registered in several other countries in Class 3 or Class 5. The appellant sought to set aside the defendant's decision and to order the defendant to register the mark. In rejecting the appellant's application for registration, the defendant had decided that since the word 'KAORI' and the Japanese characters meant 'scent or fragrance' in the Japanese language, the mark was not an invented word which had no meaning and that even ordinary Malaysians who knew the Japanese language would know what it meant. As such, the defendant ruled that the mark had a direct reference to the character and quality of the goods in respect of which the mark was registered. And, that since the mark was descriptive of the goods it represented, it was not distinctive in character and therefore the appellant should not be allowed to have a monopoly over the mark to deprive others of its use.

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Held, setting aside the defendant's decision and ordering the defendant to register the appellant's mark:

(1) An invented word may be registered as a trademark even if it meant something in a foreign language. Just because a proposed mark consisted of a word that meant something in a foreign language, it did not mean that word could never be an invented word. The appellant's mark was an invented word. It was a unique combination of a foreign word and Japanese characters. It could not be found in our local lexicons and was not in any way generally understood in Malaysia to mean what it did in Japanese. Furthermore, there was no evidence that any other traders of goods in the same Class 3 were desirous of using the word 'Kaori' or the Japanese characters in their marks. Hence, limb (c) of s 10(1) of the TMA was satisfied (see paras 30, 38–42).

(2) If Malaysians generally did not understand what the words in the mark meant and had to stop to reflect and ask what they meant or search for the meaning and if only Malaysians who understood the Japanese language could make that connection, then the mark did not have a direct reference to the character or quality of the goods that the mark was registered for. On that basis, the mark also satisfied limb (d) of s 10(1) of the TMA (see paras 47–49).

(3) The appellant's mark was also distinctive and satisfied limb (e) of s 10(1) of the TMA. It was clear from the authorities that whether a trademark was distinctive or not depended on whether other traders trading in the same or similar goods were likely to use or desire to use the same mark in the course of their trade. There was no evidence that when the appellant filed its application for registration there were other traders who had used or were desirous of using a mark similar to the appellant's. As the appellant's mark was an unique combination of a word and characters in the Japanese language and since the language was generally not understood or spoken in Malaysia, it was unlikely that other traders would desire to use the same mark in the course of their trade, unless they were actuated by improper motive (see paras 55–58).

(4) Trademark registrations were territorial in nature, subject to and governed by the provisions of the legislation of the country concerned. The fact that a trademark was registered in other countries did not bind the Registrar of Trademarks here. Consequently, the defendant could not be said to have erred in law in not registering the appellant's mark solely because the mark had been registered in several other jurisdictions. The defendant's error in law was in rejecting the appellant's application for registration on the ground that the mark did not contain or consist of at least one of the particulars in s 10(1)(c), (d) or (e) of the TMA (see paras 63–64).

[Bahasa Malaysia summary

Rayuan semasa di bawah s 25(5) Akta Cap Dagangan 1976 ('ACP') adalah terhadap penolakan defendan terhadap permohonan perayu untuk mendaftarkan cap dagangannya untuk barangan dalam Kelas 3 berkenaan dengan 'persediaan wangian'. Cap perayu terdiri daripada perkataan 'KAORI' di bawah yang mana terdapat beberapa aksara dalam bahasa Jepun. Defendan menolak permohonan perayu atas alasan bahawa cap tersebut tidak dapat didaftarkan kerana ia gagal mengandungi atau mempunyai sekurang-kurangnya satu daripada butir-butir di bawah s 10(1)(c), (d) atau (e) ACP (perenggan (a) dan (b) tidak terpakai dalam kes semasa). Dalam erti kata lain, untuk cap boleh didaftarkan, ia mestilah 'perkataan atau perkataan-perkataan rekaan' atau 'perkataan yang tidak mempunyai kaitan langsung dengan watak atau kualiti barangan atau perkhidmatan yang tidak, mengikut makna biasa, satu nama geografi atau nama keluarga' atau 'mana-mana cap dagangan tersendiri'. Perayu berhujah bahawa defendan terkhilaf bukan sahaja dalam pemakaiannya terhadap s 10(1) ACP kepada fakta kes, tetapi juga gagal untuk mempertimbangkan dengan secukupnya atau sama sekali bahawa cap perayu telah didaftarkan di beberapa negara lain dalam Kelas 3 atau Kelas 5. Perayu memohon untuk mengetepikan keputusan defendan dan memerintahkan defendan mendaftarkan cap tersebut. Dalam menolak permohonan perayu untuk pendaftaran, defendan telah memutuskan bahawa memandangkan perkataan 'KAORI' dan aksara Jepun bermaksud 'bau atau haruman' dalam bahasa Jepun, cap tersebut bukanlah perkataan rekaan yang tidak mempunyai makna malah rakyat Malaysia biasa yang tahu bahasa Jepun pasti tahu maksudnya. Oleh yang demikian, defendan memutuskan bahawa cap tersebut mempunyai rujukan langsung kepada sifat dan kualiti barang yang berkenaan dengan cap tersebut didaftarkan. Dan, oleh kerana cap tersebut adalah deskriptif barang yang diwakilinya, ia tidak mempunyai sifat tersendiri dan oleh itu perayu tidak seharusnya dibenarkan mempunyai monopoli ke atas cap tersebut untuk menghalang penggunaannya oleh orang lain.

Diputuskan, mengetepikan keputusan defendan dan memerintahkan defendan mendaftarkan cap dagangan perayu:

(1) Perkataan rekaan boleh didaftarkan sebagai cap dagangan walaupun ia bermakna sesuatu dalam bahasa asing. Hanya kerana cap dagangan yang dicadangkan terdiri daripada perkataan yang bermaksud sesuatu dalam bahasa asing, itu tidak bermakna perkataan tersebut tidak boleh menjadi perkataan rekaan. Cap dagangan perayu adalah perkataan rekaan. Ia adalah gabungan unik perkataan asing dan aksara Jepun. Ia tidak boleh ditemui dalam leksikon tempatan kita dan tidak dalam apa-apa cara umum difahami di Malaysia sebagai maksudnya dalam bahasa Jepun. Tambahan pula, tiada keterangan bahawa mana-mana peniaga barangan lain dalam Kelas 3 yang mempunyai keinginan sama menggunakan

perkataan 'Kaori' atau aksara Jepun dalam cap dagangan mereka. Oleh itu, bahagian (c) s 10(1) ACP telah dipenuhi (lihat perenggan 30, 38–42).

(2) Jika rakyat Malaysia secara amnya tidak memahami maksud perkataan dalam cap tersebut dan terpaksa berhenti untuk merenung dan bertanya apa maksudnya atau mencari maknanya dan jika hanya rakyat Malaysia yang memahami bahasa Jepun boleh membuat perkaitan tersebut, maka cap tersebut tidak mempunyai rujukan langsung kepada sifat atau kualiti barang yang didaftarkan oleh cap tersebut. Atas dasar itu, cap dagangan tersebut memenuhi bahagian (d) s 10(1) ACP (lihat perenggan 47–49).

(3) Cap perayu juga adalah bahagian (e) yang tersendiri dan memenuhi s 10(1) ACP. Ia adalah jelas daripada pihak berkuasa bahawa sama ada cap dagangan tersebut adalah tersendiri atau tidak bergantung kepada sama ada peniaga lain yang berdagang dalam barangan yang sama atau serupa berkemungkinan menggunakan atau ingin menggunakan cap dagangan yang sama dalam urusan perdagangan mereka. Tiada keterangan bahawa semasa perayu memfailkan permohonannya untuk pendaftaran terdapat peniaga lain yang telah menggunakan atau ingin menggunakan cap yang serupa dengan perayu. Memandangkan cap dangan perayu adalah gabungan unik perkataan dan aksara dalam bahasa Jepun dan memandangkan bahasa tersebut secara amnya tidak difahami atau dituturkan di Malaysia, tidak mungkin peniaga lain ingin menggunakan cap dagangan yang sama dalam urusan perdagangan mereka, melainkan mereka digerakkan oleh motif yang tidak wajar (lihat perenggan 55–58).

(4) Pendaftaran cap dagangan adalah bersifat berwilayah, tertakluk kepada dan dikawal oleh peruntukan perundangan negara berkenaan. Fakta bahawa cap dagangan telah didaftarkan di negara lain tidak mengikat Pendaftar Cap Dagangan di sini. Akibatnya, defendan tidak boleh dikatakan telah terkhilaf dari segi undang-undang kerana tidak mendaftarkan cap perayu semata-mata kerana cap tersebut telah didaftarkan di beberapa bidang kuasa lain. Kekhilafan defendan dari segi undang-undang adalah menolak permohonan perayu untuk pendaftaran atas alasan bahawa cap tersebut tidak mengandungi atau mempunyai sekurang-kurangnya satu daripada butir-butir dalam s 10(1)(c), (d) atau (e) ACP (lihat perenggan 63–64).]

Cases referred to

Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as Kheng Aik Trading) [2006] 6 MLJ 445; [2006] 3 CLJ 393, CA (refd)

Cargill Incorporated v Pendaftar Cap Dagangan [2014] 9 MLJ 99, HC (refd)

Eastman Photographic Materials Company v Comptroller-General of Patents, Designs and Trademarks [1898] AC 571, HL (refd)

Farbenfabrikan Application, In Re (1894) 1 Ch 645, Ch D (refd)

A *GS Yuasa Corp v GBI Marketing Malaysia Sdn Bhd* [2017] 8 MLJ 166, HC (refd)
Lim Yew Sing v Hummel International Sports & Leisure A/s [1996] 3 MLJ 7, CA (refd)
Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M) [2009] 9 MLJ 101, HC
B (refd)
Mark Foy's Ltd v Davies Coop & Co Ltd (1956) 1 AIPR 470, HC (refd)
Oishi Group Public Company Limited v Liwayway Marketing Corporation [2014] MLJU 1154; [2015] 2 CLJ 1121, HC (distd)
Philippart's Trademark, In Re [1908] 25 RFC 565, Ch D (refd)
C *Smith Kline & French Laboratories Ltd's Cimetidine Trade Mark, Re* [1991] RPC 17, CA (refd)
Syarikat Kenderaan Melayu Kelantan Bhd v Transport Workers' Union [1995] 2 MLJ 317; [1995] 2 CLJ 748, CA (refd)
D *Titan (M) Sdn Bhd v Registrar of Trade Marks* [2009] 7 CLJ 338 (refd)
Trademarks Registrar v W and G Du Cros Ltd [1913] 30 RPC 660; [1913] AC 624, HL (refd)
Yong Sze Fan & Anor v Sharifah binti Mohd Tamin & Ors [2008] 7 MLJ 803, HC (refd)

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Legislation referred to

Trade Marks Regulations 1997 (repealed by Trademarks Regulations 2019) reg 27
Trade Marks Act 1976 (repealed by Trademarks Act 2019) ss 10(1), 10(1)(c),
F (1)(d), (1)(e), (2A), (2B), 25(5), (7), 63(1)
Patents, Designs and Trade Marks Act 1883 [UK] s 64

Ong Boo Seng (with Kim Suh) (Linda Wang Su & Boo) for the plaintiff.
Najiha bt Rozlan (Intellectual Property Corporation of Malaysia (MyIPO)) for the
G *defendant.*

Azlan Sulaiman JC:

INTRODUCTION

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[1] This originating summons by Fumakilla Ltd ('Fumakilla') is its appeal under s 25(5) of the Trade Marks Act 1976 ('the Act'), to set aside the decision of the Registrar of Trademarks given on 7 November 2022 ('Registrar's decision') rejecting its Application No 2017069627 ('Fumakilla's application')
I to register its trademark ('mark') for goods in Class 3 in respect of 'Any fragrance preparations, all in Class 3'. The mark looks like this:

KAORI
かおり

[2] The Registrar rejected Fumakilla's application on the ground that the mark is not registrable as it did not have any of the particulars required by s 10(1)(c), (d) or (e) of the Act.

[3] Fumakilla's appeal is principally on the ground that the Registrar erred in law in making the Registrar's decision on that ground. So, apart from applying to set aside the Registrar's decision, Fumakilla is further asking for an order for the Registrar to accept Fumakilla's application and register the mark.

[4] Fumakilla further alleges that the Registrar erred in law in failing to consider sufficiently or at all that the mark had been successfully registered in several other countries, including Mexico, Myanmar, Singapore, Brunei, Philippines, Laos, Vietnam and Cambodia, in the same Class 3, for some of them also in Class 5 for 'deodorizers'.

ERROR OF LAW AND THE REGISTRAR'S DISCRETION

[5] In *Syarikat Kenderaan Melayu Kelantan Bhd v Transport Workers' Union* [1995] 2 MLJ 317; [1995] 2 CLJ 748, Gopal Sri Ram JCA (as he then was) said:

> In my judgment, the true principle may be stated as follows. An inferior tribunal or other decision-making authority, whether exercising a quasi-judicial function or purely an administrative function, has no jurisdiction to commit an error of law. Henceforth, it is no longer of concern whether the error of law is jurisdictional or not. If an inferior tribunal or other public decision-taker does make such an error, then he exceeds his jurisdiction.
>
> So too is jurisdiction exceeded, where resort is had to an unfair procedure (see *Raja Abdul Malek Muzaffar Shah bin Raja Shahruzzaman v Setiausaha Suruhanjaya Pasukan Polis* [1995] 1 MLJ 308), or where the decision reached is unreasonable, in the sense that no reasonable tribunal similarly circumstanced would have arrived at the impugned decision.
>
> *It is neither feasible nor desirable to attempt an exhaustive definition of what amounts to an error of law, for the categories of such an error are not closed. But it may be safely said that an error of law would be disclosed if the decision-maker asks himself the wrong question or takes into account irrelevant considerations or omits to take into account relevant considerations (what may be conveniently termed an Anisminic error) or if he*

misconstrues the terms of any relevant statute, or misapplies or misstates a principle of the general law. (Emphasis added.)

[6] In *Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M)* [2009] 9 MLJ 101, Ramli Ali referred to paras 15.6 and15.7 of the *Manual of Trade Marks Law & Practice in Malaysia* (2nd Ed, 2003), to which I would respectfully add para 15.5. These speak of the exercise by the Registrar of the Registrar's discretion. These paragraphs provide:

> Nature of the Discretion
>
> 15.5 Section 67 states that, in any appeal from a decision of the Registrar under the Act, the Court shall have and exercise the same discretionary powers as are conferred on the Registrar. Section 3(1) defines Court as the High Court:
>
> > In exercising his discretionary powers, therefore, the Registrar should proceed upon the same principles as motivate the Court in like case.
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> 15.6 The discretion is thus seen to be a judicial one. As Younger J said in *Stanwal TM* (1918) 35 RPC 53:
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> > The discretion must be exercised upon judicial principles and affected neither by caprice nor over caution.
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> Another helpful passage is the following from Cross J in *Rawhide TM* [1962] RPC 133:
>
> > All three members of the Court of Appeal held that the Registrar had a general discretion to refuse to register a trademark which satisfied all the positive conditions laid down by the Act. But though the Registrar in exercising his discretion is not, I think, limited to any particular type of consideration, he must exercise it judicially on reasonable grounds which are capable of being clearly stated. A vague feeling of distaste for the applicant or his methods of business cannot justify a refusal to register a mark which satisfies the conditions laid down in the Act.
>
> 15.7 It may be added that a feeling of distaste for the mark itself would not suffice for the adverse exercise of the Registrar's discretion ...

[7] Section 25(7) of the Act limits the appeal under sub-s(5) to the material the Registrar used to make its decision. It provides:

> The appeal shall be heard on the material stated by the Registrar to have been used by him in arriving at his decision and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar other than those so stated except by leave of the Court.

[8] Fumakilla adduced a copy of the Registrar's *Alasan-alasan Keputusan* which sets out the grounds for the Registrar's decision ('Registrar's grounds'). As the Registrar did not apply to add any further grounds of objection, it necessarily follows that the Registrar's grounds will be the basis upon

ascertaining whether or not she erred in law or fact in making the Registrar's decision.

[9] In other words, Fumakilla must establish from the Registrar's grounds that, by rejecting Fumakilla's application, the Registrar had asked herself the wrong question, or had taken into account irrelevant considerations, or had omitted to take into account relevant considerations, or misconstrued the terms of the Act, or misapplied or misstated a principle of the general law.

[10] Lastly, even though Fumakilla's originating summons was filed on 31 January 2023, just over three years after the trademarks Act, 2019 ('the TA 2019') came into force on 27 December 2019, it will still fall to be decided by reference to the provisions of the Act. This is because the Registrar's decision was made under that.

SECTION 10 OF THE ACT

[11] Section 10(1) of the Act provides for the particulars that make a trademark registrable under the Act:

> (1) In order for a trademark (other than a certification trademark) to be registrable, it shall contain or consist of at least one of the following particulars:
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> (a) the name of an individual, company or firm represented in a special or particular manner;
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> (b) the signature of the applicant for registration or of some predecessor in his business;
>
> (c) an invented word or words;
>
> (d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
>
> (e) any other distinctive mark.

[12] The words 'at least one of the following particulars' in s 10(1) denote that, to be entitled to be registered, a trademark need satisfy only one of limbs (a) to (e). Indeed, in *Yong Sze Fan & Anor v Sharifah binti Mohd Tamin & Ors* [2008] 7 MLJ 803, Ramli Ali J (as he then was) affirmed that to be the case, when he said:

> From the wordings of s 10(1) it is clear that only one condition needs to be satisfied for the mark to be considered to be registrable. There is no necessity for the proprietor of the mark to fulfill every single condition as that was not the intention of s 10(1). It therefore follows that a trademark which does not satisfy s 10(1)(a) does not necessarily imply that the trademark is not registrable. A trademark may still be registrable if it fulfils any one of the above conditions under s 10(1).

[13] Limbs (a) and (b) clearly do not apply to the mark because it does not contain either a name or a signature. In fact, the Registrar rejected Fumakilla's application on the basis that the mark did not have any of the particulars prescribed by limbs (c), (d) and (e).

[14] Given that the mark need only fulfil any one of them, it means that, if this court finds that it does, then this originating summons should be allowed and the mark should be registered.

THE ISSUES

[15] The issues are therefore:

(a) whether the Registrar erred in law in rejecting Fumakilla's application on the grounds that the mark did not have of the particulars under limbs (c) or (d) or (e) of s 10(1) of the Act; and

(b) whether the Registrar erred in law in failing to consider sufficiently or at all that the mark had been successfully registered in several other countries.

[16] I will now deal with each issue in turn.

Limb (c): That the mark did not consist of invented words

The Registrar's grounds on this issue

[17] The mark consists of the word 'Kaori' — the transliteration of which is 'ka-o-ri' — and some Japanese characters. In Japanese, 'kaori' means 'scent', and the Japanese characters is a combination which means 'scent/fragrance'. As the mark means 'scent' and/or 'scent/fragrance' in Japanese, the Registrar took the position that the mark was not an invented word. From the Registrar's grounds, this position dominated her decision to reject the mark on all three counts.

[18] The Registrar relied on three cases to support her conclusion that the word 'kaori' and the Japanese characters are not invented words since they mean something in Japanese.

[19] The first of those purported to be the following statement by Parker J in *In re Philippart's Trademark* [1908] 25 RFC 565 (which James Foong JCA referred to in *Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as Kheng Aik Trading)* [2006] 6 MLJ 445; [2006] 3 CLJ 393):

... To be an invented word it:

must not only be newly coined in the sense of not being already current in the English language, but must such as not convey any meaning, or, at any rate, any obvious meaning ... It must be a word having no meaning or no obvious meaning until one has been assigned to it.

[20] In the second, she referred to this statement by Lord Herschell in *Eastman Photographic Materials Company v Comptroller-General of Patents, Designs and Trademarks* [1898] AC 571:

Again, I do not think that a foreign word is an invented word simply because it has not been current in our language.

[21] Thirdly, she referred to this statement by North J in *In re Farbenfabrikan Application* (1894) 1 Ch 645:

Now, to constitute an invented word within the meaning of this section, in my mind it must be a word coined for the first time. Such a word is, of necessity incapable of having reference to the character or quality of goods, because *ex hypothesi*, it is an entirely new, unknown word incapable of conveying anything.

[22] In the Registrar's reply submissions to Fumakilla's originating summons (but not in the Registrar's grounds), the Registrar referred to a fourth case, namely *Oishi Group Public Company Limited v Liwayway Marketing Corporation* [2014] MLJU 1154; [2015] 2 CLJ 1121. That case involved, inter alia, the rejection by the Registrar of the plaintiff's application to register the mark 'Oishi' in Class 32, because of the existence of the defendant's trademarks in Classes 30 and 43 (food and beverage classes). So, the plaintiff applied to expunge the defendant's trademarks. In allowing the plaintiff's application, Azizah Nawawi JC (now JCA) said:

The plaintiff also submits that 'OISHI' or its transliteration おいしい, is a Japanese dictionary word meaning 'good taste (in reference to food items)' in English. As the Japanese culture, especially with regards to the culinary aspect, is internationally renowned and revered, the Malaysian public have come to know and/or appreciate and/or recognise the meaning of the word 'OISHI' to bear the meaning 'good taste (in reference to food items)'.

Thus, 'OISHI' is a word having direct reference to the character or quality of the goods or services of the defendant's trademarks, namely food and drink items and services, and thus is in contravention with and/or does not fulfil the criteria of registration under s 10(1)(d) of Act 175.

As 'OISHI' has a well-known dictionary meaning, I agree with the plaintiff that it is not an invented word and thus it does not fulfil the criteria for registration under s 10(1)(c) of the Act 175.

A ANALYSIS AND DECISION

[23] Having read the decisions in *Phillipart* and *Eastman Photographic*, I find that the Registrar only quotes part of what Parker J and Lord Herschell actually said in those cases. What they actually said qualifies those statements that the
B Registrar relies on.

[24] In fact, in *Phillipart*, the Registrar partly-quoted what Parker J actually said. What Parker J actually said (with the omitted words underlined) was:

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> To be an invented word, *within the meaning of the Act, a word* must not only be newly coined in the sense of not being already current in the English language, but must be such as not to convey any meaning, or at any rate any obvious meaning, *to ordinary Englishmen.* It must be a word having no meaning, or no obvious meaning, until one has been assigned to it. *I use the expression 'obvious meaning' and refer to*
D *'ordinary Englishmen' because, to prevent a newly-coined word from being an invented word, it is not enough that it might suggest some meaning to a few scholars. Further, while on the one hand the fact that a word may be found in the vocabulary of a foreign language does not, in itself, preclude it from being an invented word, so, on the other hand, a foreign word is not an invented word merely because it is not current in the*
E *English tongue.*

[25] In *Eastman Photographic*, the appellants applied to register the word 'Solio' as a trademark in Class 39 in respect of photographic paper, and the Registrar refused the application on the ground that the word 'solio' was not an
F invented word because, in Italian and in Latin, 'solio' meant 'throne', and 'sol' may be understood to mean the sun. As sunlight was in the technology at the time operative in producing impressions on photographic paper, the Registrar was of the view that it prohibited 'solio' from registration as a trademark for being descriptive of the character or quality of photographic paper.
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[26] Whilst indeed, Lord Herschell did say:

> Again, I do not think that a foreign word is an invented word simply because it has not been current in our language.

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He next said:

> At the same time, I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest
I no meaning except to a few scholars might not be regarded as an invented word.

[27] Earlier in the same judgment at p 576, Earl of Halsbury, LC said:

> My Lords, I think it is an invented word within the meaning of this statute. I know of no such word as 'Solio' in any sense which would make it intelligible here, although it is an Italian word meaning a throne, and although it is a Latin word in the ablative case with the same meaning.

[28] Then, at p 583 of the judgment, Lord MacNaghten said:

> And now if a proposed trade-mark consists of or contains an invented word or invented words it is capable of registration. But the word must be really an invented word. Nothing short of invention will do. On the other hand, nothing more seems to be required. If it is an invented word, if it is 'new and freshly coined' (to adapt an old and familiar quotation), it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skillful allusion to the character or quality of the goods. I do not think that it is necessary that it should be wholly meaningless.

[29] Two paragraphs later, Lord MacNaghten said:

> Turning to the present case, I think the word 'Solio' may pass for an invented word, and not the less so because it was hit upon by a lucky accident. I should think so even if I thought that it contained in itself an obscure reference to the great source of light while the goods were intended to be used for photographic purposes. But, speaking for myself, I must confess that without explanation from others, better scholars it may be, or worse, it never would have occurred to me to connect 'Solio' with the Latin word for the sun.

[30] These statements add a wholly different complexion to the statements (or parts thereof) that the Registrar relied on in the Registrar's grounds. In effect, they do not rule out a word being registered as a trademark simply because it means something in a foreign language. They refute the Registrar's contention that, just because a proposed mark consists of a word that means something in a foreign language, then it can never be an invented word.

[31] Further, in its submissions for the hearing under reg 27 of the Regulations on which the Registrar's decision is based, Fumakilla referred to two Malaysian cases in which the trademark that the plaintiff sought to register contained ordinary English words. The first of those was *Illinois Tool Works*.

[32] In that case, the Registrar rejected the plaintiff's application to register a trademark consisting of the words 'HIGH TEMP RED' on the ground that those were not invented words. Ramli Ali J (as he then was) held that the trademark had invented words despite them clearly being English words. He referred to that second sentence of Lord Herschell at p 581 of the judgment in *Eastman Photographic*, (that the Registrar omitted). Then, in paras 35–45, he said:

A What this means is that an invented word can have a meaning as long as the meaning is not obvious and does not deprive members of the trade from using it to describe the character or quality of the goods.

The true proposition in the *Eastman Photographic*'s case is further explained as follows:

B

> ... it seems to me that it is no objection ... that it may contain a covert and skilful allusion to the character or quality of the goods — I do not think that it is necessary that it should be wholly meaningless.
>
> ... two meanings packed up into one word. No one would say that they were not invented words. Still, they contain a meaning — a meaning is wrapped up in them if you can only find it out ... There is little danger of the apprehended mischief if invention is required as a condition of registration. After all, invention is not so very common.

C

D Therefore, an application may be allowed under the law to have some meaning in its mark and that meaning is acceptable if it is a covert and skilful allusion to the character or quality of the goods. What this means is that the meaning of the mark is not so obvious to the character or quality of the goods. If the trademark has an indirect meaning (covert and skilful allusion) it is permissible.

E In the present case, it is not disputed that for the past ten years, there is no one in the silicone industry ever wanted to use, without improper motive, the appellant's trademark or even a mark that is similar to it. There is no evidence that anyone ever wanted or desired to use the appellant's mark (except the appellant) or even a similar mark. Not even a single trademark application was ever filed. The appellant's trademark (as a singular trademark) is uncommon. Therefore, it is conclusive that the registration of the appellant's mark had not deprived other members of the trade from using the same mark as the appellant.

F

Also, the appellant's mark 'HIGH TEMP RED' does not describe, directly or indirectly, any character or quality of a silicone.

G In relation to 'invented word' of the appellant's trademark, the Registrar said:

> Orang awam dengan mudah boleh memahami keseluruhan kepada kombinasi perkataan-perkataan tersebut membawa maksud berkaitan dengan kualiti barang-barang yang dipohon.

H The Registrar is suggesting that the words in question describe the character or quality of the goods in question. The Registrar was being over-cautious. This is because no ordinary members of the public would ever think, for a second, that 'HIGH TEMP RED' means silicone. The ordinary person would never find out what 'HIGH TEMP RED' means because it does not exist as a word or a singular mark.

I

The ordinary person in the street would never know or understand that 'HIGH TEMP RED' means silicone for a gasket, cork, felt and asbestos. It would take a 'mental gymnastics' and even a 'technical scientific lab research' to find out the meaning or character or quality of a silicone. Even if they do so, which is impossible,

they will still not find out the meaning of 'HIGH TEMP RED' as referring to silicone for a gasket, cork, felt and asbestos.

The obvious conclusion one can safely and logically made in the circumstances is that the appellant's trademark 'HIGH TEMP RED', at most, is a covert and skilful allusion which is permissible in law as described by the House of Lords in *Eastman Photograpic*'s case.

As pointed out in the case of *'Scotsman' Trade Mark* [1965] RPC 358 at p 361:

> The Registrar's decision rests upon a very narrow proposition ... It should be explained that one is concerned to have regard only to some definite indication or suggestion conveyed by the word in question ... A figurative or fanciful suggestion, which the public would accept as such and no more, would not be objectionable.

On the facts of the present case, the appellant's trademark 'HIGH TEMPT RED' at most is a figurative or fanciful suggestion which is not objectionable. There is no definite indication that the appellant's mark indicates a silicone for a gasket, cork, felt and asbestos. Therefore the registration of the appellant's trademark is not objectionable.

By reason of the above, the court is satisfied that the appellant's trademark is an invented word/mark and this may be registrable as a trademark under s 10(1)(c) of the Act.

[33] The second local case that Fumakilla referred to was *Cargill Incorporated v Pendaftar Cap Dagangan* [2014] 9 MLJ 99. In that case the plaintiff applied to register 'POULTRY FOCUS' as a trademark in Class 31, in respect of non-medical animal feeds, and the Registrar rejected the application on the grounds that those two words were not invented words. Umi Kalthum J, as she then was said:

> I am more inclined to agree with the submissions of the plaintiff. I am of the view that the proposed trademark 'POULTRY FOCUS' is an invented word within the meaning of s 10(1)(c) of the Act. The combination of the words 'POULTRY' and 'FOCUS' may allude to the product sold by the plaintiff, but of themselves these words together cannot per se be said to describe the said product as the word 'FOCUS' has no real connection to the said product (see *Illinois Tool Works, Inc*'s case). This combination of the two words does not exist in the English language.
>
> It is therefore not surprising that no other persons in the trade have seen it fit to use the same combination of words to describe their products nor to apply for their marks to be registered using the same combination of words (see *Wembley Gypsum Products Sdn Bhd*'s case).

[34] Unfortunately, the Registrar did not even mention these two Malaysian cases in the Registrar's grounds and explain why she decided not to follow them. It is also unfortunate that the focus was on those portions of the

statements by Parker J and Lord Herschell in the *Phillipart* and *Eastman Photographic* cases.

[35] Given that the *Manual of Trade Marks Law & Practice in Malaysia* on the Registrar's discretion that the Registrar 'must exercise it judicially on reasonable grounds which are capable of being clearly stated', in my view it is incumbent on the Registrar to correctly and accurately quotes passages from the judgment of a case on which she relies. As for those two more recent Malaysian decisions, since they are judicial statements, then in her quasi-judicial capacity as Registrar, I am of the view that she also ought to have explained why she chose not to follow and/or distinguish them. She should not have ignored or overlooked them, which not mentioning them in the Registrar's grounds suggests. In my view, collectively these can reasonably be taken to be omissions by the Registrar to have taken into account relevant considerations, thereby rendering her decision on this issue to be an error of law.

[36] I am also of the view that, while the *Oishi* case is relevant to the circumstances of that case, it can be distinguished from our case here on its facts. Whilst it is true that Malaysians have become increasingly familiar with aspects of Japanese culinary to an extent that a large number of the populace may know, appreciate and/or recognise the meaning of the word 'OISHI' to bear the meaning 'good taste (in reference to food items)', there was nothing to suggest any corresponding familiarity with fragrances or scents in respect of which the mark was to be registered.

[37] As for *In re Farbenfabrikan*, which the Registrar relied on, in *Eastman Photographic*, Lord Herschell pointed out at p 579 of the judgment that it was one of the decisions that had been decided under s 64 of the Patents, Designs and Trade Marks Act 1883, which had been amended by the Patents, Designs and Trade Marks Act 1883. He said:

> All these decisions had reference to the provisions of s 64 of the Act of 1883 with regard to fancy words. In my opinion none of the decisions upon that part of the original section have any bearing on the new provisions to be found in the substituted section, the purpose of which was, I think, to get rid of expressions which had occasioned much embarrassment, and of all the distinctions and decisions which had been founded upon them. Those decisions, so far from affording any guide to the true interpretation of the particulars designated (d) and (e), are likely to lead to error if applied to these new provisions.

[38] Nevertheless, even if the Registrar had correctly quoted those English cases, explained why she chose not to follow those two local decisions, and applied *Oishi*'s case, it is still my view that the mark does consist of an invented word. It is my finding that, as the mark is a unique combination comprising of a foreign word and Japanese characters, cannot be found in our local lexicons,

and is not in any generally understood in Malaysia, it is an invented word. A

[39] In fact, in its written response to the Registrar's initial objection to the mark, Fumakilla adduced evidence that the word 'kaori' was not in the English or Malay lexicon. There was also no evidence that the word 'kaori' together with the Japanese characters that make up the mark are well known or understood by the ordinary Malaysian to mean what they do in Japanese. The probability of the ordinary Malaysian knowing what they mean is further lessened considerably by the word 'kaori' being paired with those Japanese characters. B C

[40] As there was also no evidence of any other party desirous of using the word 'kaori' or those Japanese characters in the mark, there was issue of other traders of goods in the same Class 3 wishing to use the mark.

[41] In conclusion, I find that the mark does consist of or contain an invented word(s) and hold that the Registrar erred in law in finding otherwise. D

[42] As I find that the mark satisfies limb (c) of s 10(1) of the Act, this originating summons should be allowed. Nevertheless, for completeness, I will still deal with the other three issues. E

Limb (d): Whether the mark has direct reference to the character and quality of the goods for which it was intended to be registered

F

The Registrar's grounds

[43] The Registrar dealt with this issue in para 12 of the Registrar's grounds.

[44] She referred to the following test adopted by Dixon CJ in the Australian case of *Mark Foy's Ltd v Davies Coop & Co Ltd* (1956) 1 AIPR 470: G

> The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess. H

[45] In her view, as the word 'kaori' in the mark meant 'scent, fragrance' in Japanese, and the Malaysian public, particularly those fluent in or able to understand Japanese would easily connect 'kaori' with air fragrance preparations goods, therefore the mark did have a direct reference to the character and quality of the goods the mark was registered for. This is what she said: I

> Pertimbangan dilakukan bagi menentukan sama ada perkataan 'Kaori' yang bermaksud 'scent, fragrance' adalah merujuk secara langsung kepada sifat atau

kualiti barangan, mengikut Seksyen 10(1)(d). Pusat Rujukan Persuratan Melayu, Dewan Bahasa dan Pustaka memberikan makna 'scent' adalah 'bau' dan 'fragrance ertinya 'haruman, wangian'. Apa yang lebih utama di dalam konteks Malaysia ialah orang awam, terutamanya golongan yang fasih atau boleh memahami bahasa Jepun, dengan mudah mengaitkan 'Kaori' iaitu 'scent, fragrance' sebagai menggambarkan sifat barangan iaitu air fragrancing preparations. Oleh itu jelas penggunaan perkataan 'Kaori' dan tulisan Jepun tersebut sebagai cap dagangan akan memberi gambaran secara langsung ke atas barangan yang diniagakan oleh pemohon.

ANALYSIS AND DECISION

[46] Unfortunately, once again the Registrar only quoted only part of what Dixon CJ said in *Mark Foy's Ltd*. Below are some other passages of what Dixon J said before his statement that she relied on:

> Indeed, to institute a search for a meaning almost necessarily implies that in ordinary English speech the words do not possess a connotation sufficiently definite to amount to a direct reference to character or quality of the goods.
>
> I venture to think, however, that a man, or for that matter a woman, hearing for the first time the words used in combination and in connection with cotton garments, would not so understand the words at once. Certainly, such a person would not so understand them intuitively and without stopping to reflect and ask himself or herself what meaning the words could really possess.
>
> Though Mr Holmes for the respondent did of course put forward the claim that 'Tub Happy' means washable, it was a meaning it was necessary to suggest. It was not a meaning that had sprung unaided to the mind and it was not one which he was able to establish by reference to instances of known usage.
>
> The reason for introducing the word 'direct' into the provision from which s 17(1)(d) comes was to check the tendency which had been disclosed by certain decisions to find a sufficient reference to the character or quality of goods in expressions from which it could only be spelled out. The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess.

[47] Fumakilla highlighted these passages in *Mark Foy's Ltd* in its submission for the hearing and in its written submissions for Fumakilla's originating summons. Fumakilla further submitted that, if the Malaysian public does not understand the words in the mark and had to stop to reflect and ask what they meant, then the mark did not have a direct reference to the character or quality of Fumakilla's goods under the mark.

[48] I agree with Fumakilla. The Registrar herself spoke of what the word 'Kaori' meant in Bahasa Malaysia, and also mentioned that the Malaysian

public, particularly those fluent in or able to understand Japanese, would make that direct connection. But, by making a search for a meaning of the word 'Kaori' and the Japanese characters in the mark and qualifying that only Malaysians fluent in or understanding Japanese would make that connection surely means that the mark did not have a direct reference to the character and quality of the goods the mark was registered for.

[49] I therefore find that the mark also satisfies limb (d) of s 10(1) of the Act.

Limb (e): That the mark was not distinctive

[50] Section 10(2A) of the Act defines what 'distinctive' means:

> For the purposes of this section, 'distinctive', in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to 15 be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

[51] Section 10(2B) of the Act then provides:

> In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which —
>
> (a) the trade mark is inherently capable of distinguishing as aforesaid; and
>
> (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

The Registrar's grounds

[52] The Registrar dealt with this issue in para 13 of the Registrar's grounds. She referred to *Trademarks Registrar v W and G Du Cros Ltd* [1913] 30 RPC 660; [1913] AC 624 in which Lord Parker said:

> The applicant for registration in effect says, 'I intend to use this mark as a trade mark, ie, for the purpose of distinguishing my goods from the goods of other persons,' and the Registrar or the Court has to determine, before the mark be admitted to registration, whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicants' chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.

[53] She then referred to *Re Smith Kline & French Laboratories Ltd's Cimetidine Trade Mark* [1991] RPC 17 in which Peter Gibson J said:

> In considering whether the claimed trade mark is inherently adapted to distinguish, the court takes account of the likelihood that other traders may, without improper motive, desire to use the trade mark in relation to their own goods. On grounds of public policy, a trader will not be allowed to obtain, by a trade mark registration, a monopoly in what other traders may legitimately wish to use.
>
> Thus, even if a mark is completely or highly distinctive in fact, the mark will not be distinctive in law if it consists of ordinary English words of description or praise or initials which other traders might have or want to use geographical names, unless of such incongruity with the specified goods as would not occur to other traders to use in relation to similar goods.

[54] The Registrar again concluded that the mark was not distinctive as the combination of the word 'Kaori' and the Japanese characters which made up the mark was descriptive of the goods under the mark, and that Fumakilla should not be allowed a monopoly over it to deprive others of its use.

ANALYSIS AND DECISION

[55] It is clear from the above authorities that whether a trademark is distinctive or not depends on whether other traders trading in the same or similar goods are likely to use or desire to use the same mark in the course of trade in connection with their goods.

[56] The Registrar also did not adduce any evidence of any similar marks that any other traders had used or expressed a desired to use, be it the word 'koari' or the 'かおり' Japanese characters in the mark, or the combination of the word 'KAORI' and the Japanese characters 'かおり' when the Fumakuilla applications was filed.

[57] As the mark is a unique combination comprising a Japanese word and characters, and that the Japanese language is generally not understood or spoken by the general public in Malaysia, I find that it is unlikely that other traders will desire to use the same mark in the course of trade, unless they are actuated by improper motive.

[58] Thus, I also find that the mark was distinctive, and therefore satisfies limb (e) of s 10(1) of the Act.

The registration of Fumakilla's mark in other countries

[59] In a nutshell, Fumakilla contends that, as it had successfully registered the mark in Mexico, Myanmar, Singapore, Brunei, Philippines, Laos, Vietnam

and Cambodia, in the same Class 3, in some of them also in Class 5 for 'deodorizers', the Registrar should have likewise accepted Fumakilla's application, and erred in law in not doing so.

[60] The Registrar dealt with this issue in para 15 of the Registrar's grounds by first referring to the following statement by Mahadev Shankar JCA in *Lim Yew Sing v Hummel International Sports & Leisure A/s* [1996] 3 MLJ 7:

> Trade mark law is very territorial in many aspects.

[61] She then referred to *Titan (M) Sdn Bhd v Registrar of Trade Marks* [2009] 7 CLJ 338. In that case, the Registrar had, like here, rejected Titan's application to register its mark 'SURE-Loc' on the grounds that it was not registrable. One of the grounds Titan sought to challenge that decision was that that mark had acquired factual distinctiveness since the appellant had registered it as a trademark in Singapore. Ramli Ali J (as he then was) said:

> The court is of the view that the trademark registrations are territorial in nature. The registration obtained by the appellant for the appellant's trademark in Singapore is not binding on the Registrar as the evaluation of the appellant's application is strictly made pursuant to the provisions of the Malaysian TMA. The respondent had rejected the appellant's application pursuant to the Malaysian TMA. The issue of inconsistency of registration as raised by the appellant does not arise because trademark law and protection is territorial in nature.

[62] This same view was expressed by Wong Kian Kheong JC (now JCA) in *GS Yuasa Corp v GBI Marketing Malaysia Sdn Bhd* [2017] 8 MLJ 166, but with a qualification in that case that does not apply here. He said:

> It is undeniable that intellectual property rights ('IP rights') in respect of a particular product may be protected and enforced in many jurisdictions. The court should not take a blinkered view regarding the protection and enforcement of IP rights. If a foreign court, especially its apex court, has decided on an issue regarding IP rights of a particular product and an identical or similar issue also arises regarding the same product in a Malaysian case, the Malaysian court should consider the foreign judgment in deciding that issue. Needless to say, Malaysian courts are not bound in any manner by any decision from a different jurisdiction. If a Malaysian court however reaches a decision which is identical or similar to that decided by a foreign court regarding IP rights of the same product, this will ensure consistency and predictability in the protection and enforcement of IP rights of that product in different jurisdictions.

[63] The fact of the matter is that registration of trademarks is indeed territorial, subject to and governed by the provisions of the legislation of the country concerned. The fact of registration of a trademark in other countries does not bind the Registrar here. Consequently, the Registrar cannot be held to

have erred in law in not following those registration in other jurisdictions, and done likewise by accepting Fumakilla's application and registering the mark.

CONCLUSION

[64] I therefore find that the Registrar did err in law in rejecting Fumakilla's application on the grounds that it did not have any of the particulars required by s 10(1)(c), (d) and (e) of the Act.

[65] I therefore made the following orders:

(a) an order that the decision of the Registrar of Trademarks dated 7 November 2022 refusing the plaintiff's application to register the

KAORI

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mark ('Plaintiff's trademark') in Class 3 via trademark Application No 2017069627 be set aside; and

(b) an order that trademark Application No 2017069627 be accepted for registration by the Registrar of Trademarks and that the Registrar of Trademarks shall issue the notice of acceptance and Form TM31 within 14 days from the date of filing by the plaintiff or its solicitors of an office copy of this judgment together with such form or payment of fees as may be required by the Registrar of Trademarks.

[66] As for costs, s 63(1) of the Act expressly provides:

> In all proceedings before the Court under this Act, the Court may award to any party such costs as it may consider reasonable and the costs as it may consider reasonable and the costs 47 of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any of the other parties.

[67] Thus, in allowing prayers 1 and 2 of the originating summons, I made no order as to costs.

The defendant's decision is set aside.

Reported by Ashok Kumar